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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/728,779      | 12/08/2003  | Kia Silverbrook      | MTB14US             | 2363             |

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BALMAIN, 2041  
AUSTRALIA

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| EXAMINER |
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UHLENHAKE, JASON S

|          |              |
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| ART UNIT | PAPER NUMBER |
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2853

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 02/23/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/728,779

Applicant(s)

SILVERBROOK, KIA

Examiner

Jason Uhlenhake

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/5/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,8-25 and 27-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-25 and 27-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/8/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/24/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-10, 15, 19 -25, 27-29, 34, 38-46, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pat. 5,796,416) in view of Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby (U.S. Pat. 5,706,041)

***Silverbrook ('416) discloses:***

- ***regarding claims 1, 19, 38***, a plurality of nozzles for supply with an ejectable liquid (Column 2, Lines 35-40, Figures 7-10)
- a heater corresponding to each of the nozzles respectively, the heater having at least one heater element configured for thermal contact with a bubble forming liquid (Column 3, Lines 30 – 41)
- drive circuits corresponding to each of the nozzles respectively for controlling the operation of the heater (Column 9, Lines 34 – 40)
- ***regarding claims 2 - 4, 20 – 22, 39 – 41***, the nozzle density is greater than 10,000, 20,000 and 40,000 nozzles per square centimeter (Column 5, Lines 39-41, Figure 8)

Art Unit: 2853

- **regarding claims 5, 24, 42:** wherein the bubble forming liquid and the ejectable liquid are of a common body of liquid ( Column 5, Lines 58 – 65)
- **regarding claims 6, 25:** configured to print on a page and to be a page-width printhead (Column 22, Lines 51 – 67)
- **regarding claims 8, 27, 44:** each heater element is configured such that an actuation energy of less than 500 nanojoules (nJ) is required to be applied to that heater element to heat that heater element sufficiently to form a said bubble in the bubble forming liquid causing the ejection of said drop (Column 11, Lines 11 – 20)
- **regarding claims 10, 29, 46:** printhead comprising a substrate having a substrate surface, wherein the area density of the nozzles relative to the substrate surface exceeds 10,000 nozzles per square cm of substrate surface (Column 2 Lines 35-40, Column 6 Lines 30-35)
- **regarding claims 15, 34, 51:** printhead comprising a plurality of nozzle chambers each corresponding to a respective nozzle, and a plurality of said heater elements being disposed within each chamber, the heater elements within each chamber formed on different respective layers to one another (Column 9, Lines 34 – 40, Figure 1b)
- **regarding claim 23:** system configured to support the bubble forming liquid in thermal contact with each heater element, and to support the ejectable liquid adjacent each nozzle (Column 3, Lines 30 – 40)

Art Unit: 2853

- **regarding claim 43:** method wherein the bubble forming liquid is fed to the at least one heater element so that it substantially surrounds the heater element (Column 3, Lines 30 – 40)

***Silverbrook ('416) does not disclose expressly the following:***

- **regarding claims 1, 19, 38,** heating the heater element to a temperature above the boiling point of the bubble forming liquid forms a gas bubble that causes the ejection of a drop of the ejectable liquid from the nozzle; wherein during use
  - at least one heater element in the form of a suspended cantilever beam having an upper and a lower face in thermal contact with a bubble forming liquid, said beam being parallel with a plane of said nozzle plate
- **regarding claim 9, 28, 45:** configured to receive a supply of the ejectable liquid at an ambient temperature, where each heater element is configured such that the energy required to be applied thereto to heat said part to cause the ejection of a said drop is less than the energy required to heat a volume of said ejectable liquid equal to the volume of the said drop, from a temperature equal to said ambient temperature to said boiling point

***Silverbrook ('836) discloses:***

- **regarding claims 1, 19, 38,** heating the heater element to a temperature above the boiling point of the bubble forming liquid forms a gas bubble that causes the ejection of a drop of the ejectable liquid from the nozzle; wherein during use (Column 14, Lines 11 – 19), for the purpose of ejecting the liquid/ink from the nozzles.

Art Unit: 2853

- **regarding claim 9, 28, 45:** configured to receive a supply of the ejectable liquid at an ambient temperature, where each heater element is configured such that the energy required to be applied thereto to heat said part to cause the ejection of a said drop is less than the energy required to heat a volume of said ejectable liquid equal to the volume of the said drop, from a temperature equal to said ambient temperature to said boiling point (Column 4, Lines 59 – 65), for the purpose of self-cooling the printhead.

**Anagnostopoulos discloses:**

- **regarding claims 1, 19, 38,** heater element in the form of a cantilever beam (66) being parallel with a plane of said nozzle plate (50) (Figure 5), for the purpose of heating the ink surface and to reduce its surface tension.

**Kubby discloses:**

- **regarding claims 1, 19, 38,** at least one heater element in the form of a suspended cantilever beam having an upper and a lower face in thermal contact with a bubble forming liquid (Figure 5; Abstract; Column 5, Lines 7-19), for the purpose of improving the overall heat-transference efficiency of the heating element.

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Silverbrook ('836), Anagnostopoulos and Kubby into the device of Silverbrook ('416), for the purpose of self – cooling the printhead, improving the overall heat-transference efficiency of the heating element and heating the ink surface and to reduce its surface tension.

Claims 11, 30, 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pat. 5,796,416) as modified by Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby (U.S. Pat. 5,706,041) as applied to claim 1 above, and further in view of Sekiya (U.S. Pub. 2002/0071001).

***Silverbrook ('416) as modified by Silverbrook ('836), Anagnostopoulos and Kubby discloses all of the claimed limitations except for the following:***

- ***regarding claims 11, 30, 47***, wherein each heater element has two opposite sides and is configured such that a said gas bubble formed by that heater element is formed at both of said sides of that heater element

***Sekiya discloses the following:***

- ***regarding claims 11, 30, 47***, wherein each heater element (9) has two opposite sides and is configured such that a said gas bubble formed by that heater element (9) is formed at both of said sides of that heater element (9) (Figure 14b, Paragraph 0039)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Sekiya into the device of Silverbrook ('416) as modified by Silverbrook ('836), Anagnostopoulos and Kubby, for the purpose of heating the ink across all surfaces of the heating element rapidly, so that the ink nearby the heating element is vaporized instantaneously to give a boiling bubble.

Claims 12, 31, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pat. 5,796,416) as modified by Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby (U.S. Pat. 5,706,041) as applied to claim 1 above, and further in view of Domoto et al (U.S. Pat. 4,580,149)

***Silverbrook ('416) as modified by Silverbrook ('836), Anagnostopoulos and Kubby discloses all of the claimed limitations except for the following:***

- ***regarding claims 12, 31, 48***, wherein the bubble which each element is configured to form is collapsible and has a point of collapse, wherein each heater element is configured such that the point of collapse of a bubble formed thereby is spaced from that heater element.

***Domoto et al discloses the following:***

- ***regarding claims 12, 31, 48***, wherein the bubble which each element is configured to form is collapsible and has a point of collapse, wherein each heater element (44) is configured such that the point of collapse of a bubble formed thereby is spaced from that heater element (44). (Column 6 Lines 1- 10, 23 – 30)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Domoto et al into the device of Silverbrook ('416) as modified by Silverbrook ('836),



Art Unit: 2853

Anagnostopoulos and Kubby, for the purpose of reducing cavitational force that erodes the heating element.

Claims 13, 32, 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pat. 5,796,416) as modified by Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby (U.S. Pat. 5,706,041) as applied to claim 1 above, and further in view of Chiou et al (U.S. Pat. 3,958,255).

***Silverbrook ('416) as modified by Silverbrook ('836),  
Anagnostopoulos and Kubby discloses all of the claimed limitations except  
for the following:***

- ***regarding claims 13,32, 50***, comprising a structure that is formed by a chemical vapor deposition (CVD), the nozzles being incorporated on the structure.

***Chiou et al discloses the following:***

- ***regarding claims 13, 32, 50***, comprising a structure that is formed by a chemical vapor deposition (CVD), the nozzles being incorporated on the structure (Column 4, Lines 45 – 58).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Chiou et al into the device of Silverbrook ('416) as modified by Silverbrook ('836) and Kubby, the purpose of using chemical vapor deposition, is well known in the art, and used to grow layers of advanced materials on the surface of a substrate.

Claims 14, 33, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pat. 5,796,416) as modified by Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby (U.S. Pat. 5,706,041) as applied to claim 1 above, and further in view of Mizutani (JP 07101058).

***Silverbrook ('416) as modified by Silverbrook ('836), Anagnostopoulos and Kubby discloses all of the claimed limitations except for the following:***

- ***regarding claims 14, 33, 49***, comprising a structure which is less than 10 microns thick, the nozzles being incorporated on the structure

***Mizutani discloses the following:***

- ***regarding claims 14, 33, 49***, comprising a structure which is less than 10 microns thick, the nozzles being incorporated on the structure (Basic-Abstract)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Mizutani into the device of Silverbrook ('416) as modified by Silverbrook ('836), Anagnostopoulos and Kubby, for the purpose of providing stable printing.

Claims 16, 35, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pat. 5,796,416) as modified by Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby (U.S. Pat.

Art Unit: 2853

5,706,041) as applied to claim 1 above, and further in view of Scheu (U.S. Pat.

4,513,298)

***Silverbrook ('416) as modified by Silverbrook ('836),***

***Anagnostopoulos and Kubby discloses all of the claimed limitations except for the following:***

- ***regarding claims 16, 35, 52***, wherein each heater element is formed of solid material more than 90% of which, by atomic proportion, is constituted by at least one periodic element having an atomic number below 50.

***Scheu discloses the following:***

- ***regarding claims 16, 35, 52***, wherein each heater element is formed of solid material more than 90% of which, by atomic proportion, is constituted by at least one periodic element (phosphorus-diffused silicon) having an atomic number below 50. (Abstract)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Scheu into the device of Silverbrook ('416) as modified by Silverbrook ('836), Anagnostopoulos and Kubby, for the purpose of heating the heater element with less energy since it is made of a material with a lower mass.

Claims 17, 36, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pat. 5,796,416) as modified by Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby (U.S. Pat.

Art Unit: 2853

5,706,041) as applied to claim 1 above, and further in view of Cornell et al (U.S. Pat. 6,637,866).

***Silverbrook ('416) as modified by Silverbrook ('836),***

***Anagnostopoulos and Kubby discloses all of the claimed limitations except for the following:***

- ***regarding claims 17, 36, 53***, each heater element includes solid material and is configured for a mass of less than 10 nanograms of the solid material of that heater element to be heated to a temperature above said boiling point to cause ejection of said drop.

***Cornell et al discloses the following:***

- ***regarding claims 17, 36, 53***, each heater element includes solid material and is configured for a mass of less than 10 nanograms of the solid material of that heater element (Figure 1 : (1)) to be heated to a temperature above said boiling point to cause ejection of said drop (Column 5, Lines14 – 20)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Cornell et al into the device of Silverbrook ('416) as modified by Silverbrook ('836), Anagnostopoulos and Kubby, for the purpose of consuming less energy while using the heating element.

Claims 18, 37, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook (U.S. Pat. 5,796,416) as modified by Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby

Art Unit: 2853

(U.S. Pat. 5,706,041) as applied to claim 1 above, and further in view of Ura (U.S. Pat. 3,973,106).

***Silverbrook ('416) as modified by Silverbrook ('836) and Kubby discloses all of the claimed limitations except for the following:***

- ***regarding claims 18, 37, 54***, each heater element is substantially covered by a conformal protective coating, the coating of each heater element having been applied substantially to all sides of the heater element simultaneously such that the coating is seamless.

***Ura discloses the following:***

- ***regarding claims 18, 37, 54***, each heater element is substantially covered by a conformal protective coating, the coating of each heater element having been applied substantially to all sides of the heater element simultaneously such that the coating is seamless. (Abstract, Column 1 Lines 27 – 34)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Ura into the device of Silverbrook ('416) as modified by Silverbrook ('836), Anagnostopoulos and Kubby, for the purpose of providing better adhesion and improving the life span of the heater element.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-6, 8-25, 27-54 have been considered but are moot in view of the new ground(s) of rejection. Please see

Art Unit: 2853

the above rejections regarding Silverbrook (U.S. Pat. 5,796,416) in view of Silverbrook (U.S. Pat. 5,856,836), Anagnostopoulos et al (U.S. Pat. 5,12,159) and Kubby (U.S. Pat. 5,706,041)

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2853

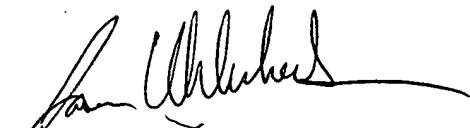
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Uhlenhake whose telephone number is (571) 272-5916. The examiner can normally be reached on Monday - Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JSU

February 12, 2007



**STEPHEN MEIER**  
**SUPERVISORY PATENT EXAMINER**